

REMARKS

A preliminary amendment is included herein to update that status of applications listed in the priority claim.

Applicants provisionally elect, with traverse, Group I, Claims 1-11 and 14; for a species for examination purposes, Applicants provisionally elect, with traverse, the species wherein "A" is a piperidine core (*i.e.*, the 6-membered core shown in Claim 1), R¹ is phenyl (*i.e.*, a monocyclic aryl), R² is methoxy (*i.e.* R² is -(CH₂)₆-OR³ and R³ is C₁-alkyl), "X" is hydrogen, and "Y" is hydroxy. Claims 1, 3, 4, and 14 read upon the elected species.

Because Applicants have elected product claims, Applicants explicitly reserve their right to rejoin suitable process claims upon an indication of allowable subject matter in the elected product claims (see MPEP §821.04 *et seq.*).

Restriction is proper only if the restricted claims are independent or patentably distinct and there is no serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted claims (MPEP §803). Applicants respectfully traverse the restriction requirement on the grounds that the Office has not carried the burden of providing any reasons and/or examples to support the conclusion that the claims of the restricted groups are distinct.

The Office has characterized the claims of Groups I and III as being directed to related products. Citing MPEP 806.05(j), the Examiner states that claims in this relationship can be shown to be distinct if: (A) the inventions *as claimed* do not overlap in scope, *i.e.*, they are mutually exclusive; (B) the inventions *as claimed* are not obvious variants; and (C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect. Note that the three requirements are separated by an "and" not an "or." Thus, all three prongs must be satisfied to support a restriction pursuant to this section of the MPEP. The Examiner goes on to state that, in the present application, prior art directed to the "solution phase" compounds of Group I would not anticipate the product recited in Claim 13. Applicants respectfully traverse this comment as being nothing more than a restatement of the conclusion of patentable distinctness itself. The

Examiner further notes that "nothing on the record indicates that the products are obvious variants of one another." Insofar as Claim 13 refers back to Claim 12, and Claim 12 recites a list of compound that are co-extensive with Claim 1, Applicants respectfully traverse this comments as not comporting with the actual language of the claims. Lastly, the Office indicates that the products have different modes of operation, function, or effect. However, the Office does not articulate those differences, nor how those differences function to render the claimed products patentably distinct.

The Office has characterized the relationship between Groups II and III as process of making and product made. Citing MPEP §806.05(f), the Examiner states that claims in this relationship can be shown to be distinct if either of the following can be shown: (1) that the process as claimed can be used to make other and materially different product; or (2) that the product as claimed can be made by another and materially different process. The Examiner goes on to state that, in the present application, the process as claimed can be used to make other libraries. Applicant submits that the reason offered by the Examiner is insufficient to support a conclusion of patentable distinctness between the restricted claims. The Examiner has provided no indication as to the means or the feasibility of manufacturing other chemical compound libraries using the claimed process. Also, restriction is evaluated in terms of the invention as claimed. If the actual steps of the claim were altered (such as by removing the "random" steps as noted by the Office at paragraph 4 of the Office Action), the resulting claim would no longer be the present invention "as claimed," but rather some other invention.

The Office made no remarks with respect to any patentable distinction between the claims of Group I and Group II. Applicants thus submit that the restriction between these two groups of claims is untenable.

Accordingly, because the Office has not carried the burden of providing technologically sound reasons or examples for concluding that the claims of the restricted groups are patentably distinct, the restriction requirement is improper and should be withdrawn.

In the same fashion as a restriction requirement, an election of species requirement is proper only if the restricted species are independent or patentably distinct and there is no serious burden placed on the Office if an election is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted species (MPEP §803). Applicants respectfully traverse the election of species requirement on the grounds that the Office has not carried the burden of providing any reason and/or example to support the conclusion that the restricted species are, in fact, distinct.

Specifically, the Office notes, at the bottom of page 4 of the Office Action, that the species are distinct because "their structures and modes of action are different," and that the compounds "differ in their reactivity and the starting materials from which they are made." Applicants respectfully submit that the reasons offered by the Office are insufficient to support a conclusion of patentable distinctness between the restricted species. First, stating that the claimed compounds will have distinct chemical properties is a tautology - they are different compounds within a group of related compounds (*i.e.*, oligomeric compounds comprised of substituted pyrrolidine and/or piperidine residues). While their chemical properties will be similar, they certainly will not be identical. That statement, however, is nothing more than a restatement of the conclusion of patentable distinctness itself. Simply because the Markush-type claims can be parsed into mutually exclusive species does not mean that the individual species themselves are patentably distinct. The Office must show that the individual species are "patentably distinct," not merely mutually exclusive.

With regard to election of species requirements involving Markush-type claims, the Examiner's attention is directed to MPEP §803.02:

If the members of the Markush groups are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case the, examiner will not follow the procedure described below and will not require restriction.

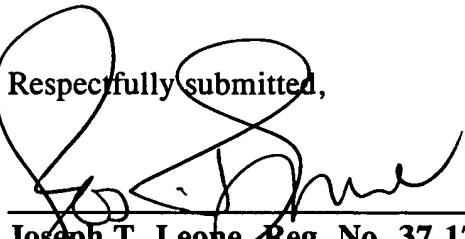
In the present case, Applicants respectfully note that the Markush recitation of Claim 1 recites only two core structures, both of which are di-substituted, nitrogen-containing heterocycles. Two members is an exceedingly small and well-contained group. The two core structures are a pyrrolidine ring and a piperidine ring and thus structurally related. Therefore, Applicants respectfully submit that MPEP §803.02, quoted above, controls and the election of species requirement is improper.

With the provisional election of a single species, should no prior art be found that anticipates or renders obvious the elected species, Applicants note that the search of the Markush-type claims will be extended (MPEP §803.02).

Accordingly, because the Office has not carried the burden of providing technologically sound reasons or examples for concluding that the restricted species are patentably distinct, the election of species requirement is improper and should be withdrawn.

Applicants submit that the application is now in condition examination on the merits. Early notification of such action is earnestly solicited.

Respectfully submitted,


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